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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,742	09/21/2000	Rafael Alos	160383.90180	1467
7590 12/08/2004			EXAMINER	
Michael J McGovern Quarles & Brady 411 East Wisconsin Avenue Milwaukee, WI 53202-4497			FERRIS, DERRICK W	
			ART UNIT	PAPER NUMBER
			2663	

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/600,742

Applicant(s)

ALOS, RAFAEL

Examiner

Derrick W. Ferris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/04 has been entered.

Response to Amendment

2. **Claims 1-15** as amended are still in consideration for this application. Applicant has amended claims **1, 3, 6, and 11**.

3. Examiner thanks applicant for providing corrected drawings.

4. Examiner **withdraws** the 112-1st paragraph rejection based on applicant's claim amendments.

5. Examiner **withdraws** the obviousness rejection to *Belpaire* in view of *Svobodova* for Office action filed 05/26/04. In particular, the rejection is withdrawn based on applicant's claim amendment. However, the examiner strongly encourages applicant to clearly state any claim limitations at issue instead of arguing limitations not recited in the claims (e.g., underlining the claim limitation at issue). As necessitated by amendment, please see the new rejection below.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-3, 5-13, and 15** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,841,764 A to *Roderique et al.* ("*Roderique*").

As to **claim 1**, in figure 3 *Roderique* shows a first transmission device as radios 28, 30, a first network as the RF data network 10 (i.e., cellular in reference to column 3, line 18), a second transmission device as hosts A, B, or N, and a second network as Ethernet network 12 (i.e., Internet type in reference to column 6, line 65). As such, a packet or message is made up of a header (i.e., a signaling field) and a data portion (i.e., useful data). In particular, the gateway 40 combined with data interface module 38 formats the packets in both directions. The gateway 40 is responsible for data adaptation and for controlling of routing onto the network as shown in figure 3. Specifically, in the direction of Ethernet (Internet) to RF (cellular), the data packet header is converted into a radio header which is smaller than the standard IP header and in the direction of RF (cellular) to Ethernet (Internet), the data packet header is converted into an IP header that is larger than the RF header, see e.g., the abstract and figure 4. In addition, the reference teaches that optionally the messages sent from the Ethernet network (i.e., IP packets) may be fragmented first; however, if the size is small enough then no fragmentation is necessary, see e.g., column 8, lines 54-67 and column 12, lines 16-34. In particular, if no fragmentation is needed than a Short Radio Network Layer Header is used. Packets sent from the radio network are not fragmented since the size is already fixed. Hence only the header of the packet is modified (i.e., extracted and reformed and thus not encapsulated)

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through the gateway at a network layer where the payload is left untouched, see e.g., column 7, lines 37-40.

As to **claims 2 and 3**, see e.g., the abstract where a code word is a “predetermined field”.

As to **claim 5**, since the packet must first be created, the two packet fields (i.e., the header and payload) are first extracted.

As to **claim 6**, see similar rejection to claim 1.

As to **claim 7**, see similar rejection to claim 2.

As to **claim 8**, see similar rejection to claim 3.

As to **claim 9**, see the extended address field in figures 5a and 5b, see e.g., column 8, lines 37-39.

As to **claim 10**, see similar rejection to claim 5.

As to **claim 11**, see similar rejection to claim 1. In particular, since the gateway performs the steps of routing, transmission, and adaptation (see similar rejection to claim 1) the gateway contains circuits to perform these functions.

As to **claim 12**, see similar rejection to claim 2.

As to **claim 13**, see similar rejection to claim 3.

As to **claim 15**, see similar rejection to claim 5.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 4 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,841,764 A to *Roderique et al.* ("*Roderique*") in view of "Short Message Service Based Applications in the GSM Network" to *Collesei et al.* ("*Collesei*").

As such to **claim 4**, *Roderique* discloses the limitations in the base claim.

Roderique is silent or deficient to the further limitation wherein the data are transmitted between a first, *GSM network*, and a second Internet network, by accommodating Internet addresses in the signalling fields of *SMS packets*.

Collesei teaches the further recited limitation above at e.g., the SMS service in Section II on page 940.

The proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify *Roderique* by clarifying that text messaging is SMS based on GSM.

As such, examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include limitation mentioned above. In particular, the motivation for modifying the reference or to combine the reference teachings would be to provide data services in a cellular network. In particular, *Collesei* cures the above-cited deficiency by providing a motivation found at e.g., the abstract. Second, there would be a reasonable expectation of success since *Roderique* teaches text messaging where SMS is a form of text messaging, see e.g., column 3, line 55 of *Roderique*. Thus the references either in singular or in combination teach the above claim limitation(s).

As to **claim 14**, see similar rejection to claim 4.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (571) 272-3123.


The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (571) 272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Derrick W. Ferris
Examiner
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DWF


CHI PHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800 12/6/09